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EXAMINER

BELL, KENT L

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 05/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/007,711

Applicant(s)

MAN

Examiner

KENT L. BELL

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to ~~communications~~ filed on application filed 11/13/01.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/13/01 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☒ Other: Rule 1.105 Requirement

**Detailed Action**

**Objection to the Drawing**

**37 CFR 1.165**

The following is a quotation of section (a) of 37 CFR 1.165(a):

(a) Plant patent drawings are not mechanical drawings and should be artistically and competently executed. Figure numbers and reference characters need not be employed unless required by the Examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual representation.

The drawing is objected to under 37 CFR 1.165(a) as the color illustration of record is not competently and/or artistically executed. The illustration of record is so out of focus, blurry, and dark that it meaningfully conveys no useful information. Applicant is reminded that it is the entire plant for which plant patent protection is sought, as such, applicant needs to provide description (be it in written or photographic form) for all characteristic plant features capable of same. A whole plant view, if artistically and competently executed (being in focus, not blurry, and not dark), would show characteristic branching, branching aspect, relative foliage density, foliage shape, relative bloom quantity, bloom shape, and characteristics on a whole plant level. While applicant may not consider these features to be the main patentable differences or distinctions, they need to be described and/or illustrated so as to provide as complete a botanical description of the plant as is reasonably possible (37 CFR 1.163(a)).

**Detailed Action**

**Objection to the Declaration**

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the instant plant was found in a cultivated area. In addition to the Declaration stating that the instant plant was asexually reproduced, the declaration “must also state that it was found in a cultivated area” “where the plant is a newly found plant” (MPEP 1604, 37 CFR 1.162). Such as, for example, “I state that I have invented or discovered in a cultivated area the new and distinct plant.”. Appropriate correction is required.

**Objection to the Disclosure**

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

**35 USC § 112**

**Detailed Action**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

**Detailed Action**

A. The disclosure is objected to under 37 CFR 1.121(e) because the Latin name of the genus and species of the claimed plant and Variety Denomination of the claimed plant should be preceded by a heading as set forth in 37 CFR 1.163(c)(4)(5) and 37 CFR 1.163(d). This information should be set forth before the “Background of the Invention” section as set forth in 37 CFR 1.163(c).

B. Page 1, lines 21-23, Applicant has stated how the instant cultivar was first asexually reproduced but does not “particularly point out where” the instant plant was first asexually reproduced. Applicant should set forth in the specification the location where the instant plant was first asexually reproduced.

C. Page 1, lines 27-32, Applicant should set forth in the specification the age of the plants when described and container size (if grown in a container) in a specified location of culture.

D. Page 1, line 34 to page 2, line 1, Applicant should be deleted as this information should be imported to the beginning of the specification as set forth in “A” above.

**Detailed Action**

E. Page 2, line 3, Applicant sets forth a height but does not state whether it is from the media surface to either the top of the leaf plane or top of the flowers. Correction and/or clarification is necessary. Applicant should set forth in the specification the height from the media surface to the top of the leaf plane and top of the flowers.

F. Page 2, line 9, Applicant states "Rooting habit". It appears --Root description-- may be more appropriate to state in this instance. Correction and/or clarification is necessary.

G. Page 2, lines 10-16, Applicant should set forth in the specification additional information relative to the instant plant's lateral branches including the typical and observed coloration with reference to the employed color chart.

H. Page 2, line 22, Applicant should set forth in the specification additional information relative to the instant plant's stipules including the typical and observed shape, apex, margin, and base descriptors and coloration (both surfaces) with reference to the employed color chart.

I. Page 2, line 28, Applicant states venation is "light green". Applicant should set forth in the specification a color designation(s) for the "light green" coloration. The recitation "light

**Detailed Action**

green” is vague and insufficient in this regard. Additionally, applicant should set forth a color designation(s) for both surfaces.

J. Page 2, line 29, Applicant should set forth in the specification additional information relative to the instant plant’s petioles including the typical and observed coloration with reference to the employed color chart.

K. Page 2, line 31, Applicant should set forth in the specification additional information relative to the instant plant’s flowering habit including the typical and observed flower arrangement, i.e. arranged on axillary cymes, if such is accurate, cyme diameter, number of flowers per cyme, and number of flowers per plant in the interest of providing as complete a description of the plant as is reasonably possible.

L. Page 2, line 32, Applicant should set forth in the specification additional information relative to the instant plant’s flowers including the typical and observed shape and fragrance.

M. Page 3, lines 14, Applicant should set forth in the specification additional information relative to the instant plant’s tepals including the typical and observed apex and base descriptors.



**Detailed Action**

N. Page 3, lines 8 and 11, Applicant should delete “petals” and insert --tepals--. Tepals is the more appropriate botanical term to use in these instances.

O. Page 3, line 14, Applicant states tepal lower surface is “Red Group 36D to Red Group 49C”. However, applicant has previously stated the “Outer tepal, middle lower side” is “Red Group 36 D” and the “Inner tepal, margin lower side” is “Red Group 48D” at page 1, lines 15 and 16, and lines 19 and 20, respectively. The recitation on page 3, line 14 is contradictory to the recitations on page 1, lines 15 and 16 and lines 19 and 20. Correction and/or clarification is necessary.

P. Page 3, line 15, Applicant should set forth in the specification additional information relative to the instant plant’s buds including the typical and observed shape and coloration with reference to the employed color chart.

Q. Page 3, line 30, Applicant states bracts are “Light green”. Applicant should set forth in the specification a color designation(s) for the “Light green” coloration. The recitation “Light green” is vague and insufficient in this regard. Additionally, applicant should set forth a color designation(s) for both surfaces.

**Detailed Action**

R. Page 3, line 32, Applicant states flower longevity is “3-4 weeks” but has not stated whether this is on or off the plant. Correction and/or clarification is necessary. Applicant should set forth in the specification the lastingness of an individual bloom on and off the plant.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

**Claim Rejection**

**35 U.S.C. 112, 1st & 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

**Potential Issue Under 35 U.S.C. 102**

The claimed Begonia variety ‘Kristy Franje’ is described in Breeder’s Right application number BGN0251 filed in The Netherlands on April 21, 1998 and published on May 16, 1998. The published application is a “printed publication” under 35 U.S.C. 102 because it is accessible

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to persons concerned with the art to which the documents relate. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. For example, UPOV publishes the application number, date of publication, species of plant and variety denomination for PBR certificates, and copies of the application (BGN0251) are obtainable through The Netherlands Register of Varieties, a register of applications including the name and description of the plant variety. This register is open to public inspection and the information in this register is published in the *Nederlandse Staatscourant*. Thus information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d 1618, 1620, (Bd. Pat. App. & Inter. 1992)(“The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”).

While the publication cited above discloses the claimed plant variety, a question remains as to whether the reference is enabling. If the plant was publicly available, then the application,

**Detailed Action**

combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited. Search of electronic databases, the internet and the Office's collection of retail catalogs has not revealed any evidence that the claimed plant was on sale anywhere in the world. However, the Office's collection of retail catalogs is not comprehensive. Furthermore, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties free of charge. Since the inventor and assignee of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information in the attached Requirement for Information Under 37 CFR 1.105.

This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

**Comments**

Due to the amount of revision seen necessary in this application, it is suggested that Applicant file a substitute specification, incorporating all additions, deletions and modifications so as to provide the printer a clean copy at the time of allowance. Applicant should specifically

**Detailed Action**

authorize cancellation of the present specification to the same. Further, a clean copy and marked up copy (showing any addition, deletion, and/or modification) of the substitute specification should be submitted.

**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (703) 306-3224. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

KENT L. BELL  
PATENT EXAMINER

*Kent L. Bell*

**Detailed Action**

**REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105**

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined reasonably necessary to the examination of this application.

The information is required to determine when, if ever, the claimed plant variety, 'Kristy Franje', was publicly available prior to the filing date of the instant application.

In response to this requirement please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution. Also, please provide copies of the published Netherlands application (BGN0251). The Office does not maintain a collection of Breeders' Rights documents and they are not readily obtainable electronically. It is reasonable to expect that Applicant can readily obtain the requested document(s) and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

**Detailed Action**

Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is three months.